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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,825	10/16/2003	Xiaoru Wang	82897AD-W	8478

7590 09/12/2007
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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

MAIL DATE	DELIVERY MODE
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09/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/686,825	Applicant(s) WANG ET AL.	
	Examiner Callie E. Shosho	Art Unit 1714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 30 November 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1,2,4-7 and 9-15.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Attachment to Advisory Action

1. This Advisory Action is set forth in response to applicants' after-final response filed 11/30/06 which the examiner has previously not responded to.

It is recognized that an Appeal Brief has been filed on 6/6/07. It is noted that a response to the Appeal Brief will be forthcoming in a separate mailing.

2. Applicants' arguments filed 11/30/06 have been fully considered but they are not persuasive.

Specifically, applicants argue that Ishii et al. is not a relevant reference against the present claims given that while the purpose of Ishii et al. is to agglomerate the colorant particle in an electrostatic ink jet system, the purpose of the present invention is to avoid agglomeration in a thermal inkjet recording system.

Firstly, with respect to the fact that Ishii et al. utilizes ink in electrostatic ink jet system while the present invention utilizes thermal ink jet system, it is noted that the present claims are drawn to ink composition not method of using or printing the ink. Thus, the present claims are open to ink utilized in any ink jet recording system including electrostatic ink jet system such as that disclosed by Ishii et al.

Further, while it is agreed that Ishii et al. disclose that the colored resins, i.e. composite colorant polymer particles, are ejected from the ink jet printer as agglomerates, it is noted that the formation of such agglomerates only occurs upon printing of the ink, i.e. during method of printing the ink. However, as set forth above, the present claims are not drawn to method of

using or printing the ink but rather to the ink composition itself. Attention is drawn to col.23, lines 26-29 of Ishii et al. that disclose that the ink comprises colored particles, i.e. composite colorant polymer particle, possessing average particle diameter of 0.05-5 μm or preferably 0.1-1.5 μm that clearly overlaps the presently claimed composite colorant particle average particle size. As set forth in MPEP 2144.05, in the case where the claimed range "overlap or lie inside ranges disclosed by the prior art", a *prima facie* case of obviousness exists, *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). It would have been obvious to one of ordinary skill in the art to control the average particle size of the composite colorant polymer particle in Ishii et al. to average particle size including that presently claimed in order to produce ink that is effectively printed from printing apparatus. Further, in response to applicants' arguments regarding the use of agglomerates in Ishii et al., it is clear that the size of the composite colorant polymer particles would affect the size of the agglomerates prepared therefrom. Attention is drawn to col.6, lines 53-58 of Ishii et al. that disclose that the colored particles in the ink are agglomerated upon printing in order to form dense and sharp image without blurring. Thus, it also would have been obvious to one of ordinary skill in the art to control the average particle size of the composite colorant polymer particles in Ishii et al. to average particle size, including that presently claimed, in order to form agglomerate of the composite colorant polymer particle such that the ink forms dense and sharp image without blurring.

Applicants also argue that the examples of Ishii et al. utilize composite colorant polymer particle with average particle size outside the scope of the present claims.

However, “applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others”, *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). A fair reading of the reference as a whole clearly discloses that the composite colorant polymer particle possess average particle size of 0.05-5 μm or preferably 0.1-1.5 μm that clearly overlaps the presently claimed composite colorant particle average particle size.

With respect to present claim 2 and present claim 15, applicants argue that the present product is different based on its method of preparation which is the key aspect of the present invention resulting in superior stability as shown in Table 2 of the present specification and that the examiner improperly ignores explicit and important limitations in the claims based on an improper reading of the case law on product-by-process claims.

However, the examiner’s position remains that “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself”. See MPEP 2113. Thus, although Ishii et al. do not disclose the presently claimed process for making the composite colorant polymer particles, it is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) .

Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983).

Therefore, absent evidence of criticality regarding the presently process and given that Ishii et al. meet the requirements of the claimed composite colorant polymer particles, it is clear that Ishii et al. meet the requirements of present claims 2 and 15. It is the examiner’s position that applicants have not met the burden of coming forward with evidence establishing an unobvious difference between the claimed product and the prior art product.

Applicants point to Table 2 of the present specification. The Table compares ink within the scope of the present claims (examples 1-9) with ink outside the scope of present claims 2 and 15, i.e. comprising no polymer (example C-1) or producing the composite colorant polymer by different method (C-2 or C-3). It is shown that the ink of the present invention is superior in terms of optical density and has particle size that falls within the scope of the present claims.

However, it is the examiner’s position that the data is not persuasive given that the data is not commensurate in scope with the scope of the “closest” prior art Ishii et al. given that the comparative data does not compare ink as presently claimed with ink outside the scope of the present claims but within the scope of Ishii et al. That is, Ishii et al. disclose preparing the colored resin particle by pulverizing method or polymerization granulation methods not by the method of comparative examples C-2 or C-3. Thus, not only is the process utilized in each of comparative examples C-2 and C-3 outside the scope of the present claims but also outside the

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scope of Ishii et al. Further, with respect to example C-1, the data is not persuasive given that Ishii et al. already recognizes the criticality of using polymer.

Further, the data is not persuasive given that the data is not commensurate in scope with the scope of the present claims given that there is only data at a few values of the average particle size. There is no data at the lower, middle, or upper end of the presently claimed average particle size of the composite colorant polymer particles. As set forth in MPEP 716.02(d), whether unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support". In other words, the showing of unexpected results must be reviewed to see if the results occurred over the entire claimed range, *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980). Applicants have not provided data to show that the unexpected results do in fact occur over the entire claimed range of average particle size of the composite colorant polymer particles.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
9/10/07